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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/781,453	02/13/2001	Norihiko Nakagawa	1155-0215P	1019

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EXAMINER
SHOSHO, CALLIE E

ART UNIT	PAPER NUMBER
1714	

DATE MAILED: 07/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No.	Applicant(s)	
	09/781,453	NAKAGAWA ET AL.	
	Examiner	Art Unit	
	Callie E. Shosho	1714	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 19 June 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☐ The proposed amendment(s) will not be entered because:

   (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☐ they raise the issue of new matter (see Note below);

   (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____.

3. ☒ Applicant's reply has overcome the following rejection(s): rejections utilizing Yamamoto et al. (U.S. 5,656,696).

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *see attachment*.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a)☐ will not be entered or b)☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: _____.

   Claim(s) rejected: *1 and 3-13*.

   Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10. ☐ Other: _____

Callie E. Shosho
Primary Examiner
Art Unit: 1714

Attachment to Advisory Action

1. Applicants' arguments filed 6/19/03 have been fully considered but, with the exception of arguments relating to Yamamoto et al. (U.S. 5,656,696), they are not persuasive.

Applicants argue that the data of the present specification demonstrates unexpected results over EP 716121. Specifically, applicants argue that the gloss values of the present invention demonstrate unexpected results over EP 716121. As evidence to support this position, applicants point to the gloss values in Tables 4 and 5 of EP 716121, specifically, examples 7, 10, 13, and 15 which are most comparable to inventive examples 1 and 2 found in Table 1 of the present specification, and note that the gloss values exhibited by the compositions of EP 716121 are inferior to the gloss values of the presently claimed compositions.

It is agreed that the gloss values of the present compositions are superior to those found in the examples cited by applicants in Tables 4 and 5 of EP 716121. However, there is no disclosure in EP 716121 of low density polyethylene as required in the present claims, and thus, one would not expect all the properties of these composition of EP 716121 to be the same as those of the presently claimed compositions. Further, this is why EP 716121 is used in combination with JP 54120656 which teaches the use of low density polyethylene. Although the motivation to combine is not to improve gloss, it is noted that obviousness under 103 is not negated because the motivation to arrive at the claimed invention as disclosed by the prior art does not agree with appellant's motivation. *In re Dillon*, 16 USPQ2d 1897 (Fed. Cir. 1990), *In re Tomlinson*, 150 USPQ 623 (CCPA 1996).

Further, although there is no disclosure in EP 716121 or JP 54120656 of gloss as set forth in the inventive examples found in Table 1 of the present specification, it is noted that there is no

requirement in the present claims regarding gloss. Additionally, given that combination of EP 716121 with JP 54120656 discloses composition identical to that presently claimed, it is clear that such composition would intrinsically possess as presently claimed.

It is noted that applicants set forth comparative examples in Table 1 of the specification. The data compares composition within the scope of the present claims, i.e. comprising propylene/1-butene random copolymer and low density polyethylene as presently claimed, with composition outside the scope of the present claims, i.e. comprising propylene/1-butene random copolymer only. It is shown that the present invention is superior in terms of lamination speed and "neck-in". However, this is the same motivation disclosed in JP 54120656 for using low density polyethylene. Attention is drawn to Table 1 of JP 54120656 wherein comparative example 2, which comprises propylene/1-butene random copolymer only (no low density polyethylene), is shown to be inferior in terms of lamination speed and "neck-in". Thus, the comparative data of the present specification is not successful in establishing unexpected or surprising results over the cited prior art given that JP 54120656 already disclose the criticality of using low density polyethylene.

Applicants argue that Sugano et al. do not disclose blend of low density polyethylene and propylene/1-butene random copolymer as presently claimed. However, it is noted that col.5, lines 8-11 and col.6, line 13 of Sugano et al. disclose the use of propylene/1-butene random copolymer and low density polyethylene.

Applicants also argue that JP 54120656 is not a relevant reference against the present claims given that JP 54120656 does not disclose propylene/1-butene random copolymer with

molecular weight distribution, i.e. M_w/M_n, or B value as presently claimed while the comparative data in the specification establishes the criticality of presently claimed M_w/M_n and B.

The comparative data compares composition with the scope of the present claimed, i.e. comprising propylene/1-butene random copolymer with M_w/M_n and B value as presently claimed, i.e. examples 1 and 2, with composition outside the scope of the present claims, i.e. comprising propylene/1-butene random copolymer with M_w/M_n and B value outside the scope of the present claims, comparative examples 2 and 3. It is shown that the compositions of the present invention are superior in terms of transparency (less haze) and gloss.

While JP 54120656 discloses composition comprising propylene/1-butene random copolymer and low density polyethylene, it is agreed that JP 54120656 does not disclose M_w/M_n or B value for the propylene/1-butene random copolymer. However, this is why JP 54120656 is used in combination with EP 716121 which discloses propylene/1-butene random copolymer with M_w/M_n and B value as presently claimed. Further, it is noted that Table 4-II of EP 716121 compares composition comprising M_w/M_n and B value as presently claimed (example 10) with composition comprising M_w/M_n and B value outside the scope of the present claimed (comparative example 4). It is shown that composition with M_w/M_n and B value as presently claimed are superior in terms of gloss and transparency which is the same motivation for using propylene/1-butene random copolymer with M_w/M_n and B value as presently claimed as found in the comparative data of the present specification. Thus, it is the examiner's position that the comparative data of the present specification is not successful in establishing unexpected or surprising results over JP 54120656 in view of EP 716121 given that EP 716121 already

discloses the criticality of using propylene/1-butene random copolymer with M_w/M_n and B value as presently claimed.

Applicants also argue that there is no motivation to use Sadatoshi et al. (U.S. 5,340,878) given that Sadatoshi et al. do not disclose the use of low density polyethylene as presently claimed or any motivation to use Yoshimura et al. (U.S. 5,443,765) given that Yoshimura et al. is completely silent with respect to optical properties. However, it is noted that there is no requirement in the claims regarding optical properties. Further, it is noted that Sadatoshi et al. and Yoshimura et al. are used as teaching references, and therefore, it is not necessary for these secondary reference to contain all the features of the presently claimed invention, *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973), *In re Keller* 624 F.2d 413, 208 USPQ 871, 881 (CCPA 1981). Rather these reference teaches a certain concept, namely melt flow rate of propylene/1-butene random copolymer (Sadatoshi et al.) and specific type of low density polyethylene (Yoshimura et al.), and in combination with the primary reference, disclose the presently claimed invention. If the secondary reference contained all the features of the present claimed invention, it would be identical to the present claimed invention, and there would be no need for secondary references.

Callie E. Shosho
Primary Examiner
Art Unit 1714

CS
July 2, 2003